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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/663,250	09/15/2000	David G. Matsuura	18608-001910	3797

7590 04/21/2004
Jonathan Spangler
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San Diego, CA 92131

EXAMINER

DAVIS, DANIEL J

ART UNIT	PAPER NUMBER
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3731

16

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/663,250

Applicant(s)

MATSUURA ET AL.

Examiner

D. Jacob Davis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10 and 11 is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 6, 8, 14 and 15 is/are rejected.
- 7) ☒ Claim(s) 4, 7, 9, 12, 13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5, 6, 8, 14 and 15 are rejected under 35 U.S.C. 102(b) as anticipated by Forber et al. (US 5,733,294). Forber discloses a genererally cylindrical shaped mesh 22 (element 228 is the wire while element 22 is generally the mesh) in Fig. 10. The mesh as illustrated is expanded against the sides of the wall of the aneurysm hole. The “connection” 25 is moved (by interior forces) into an interior portion of the mesh. The proximal end of the mesh is “moved in a distal direction.”

Regarding claim 3, a push rod is used to advance the device out of the catheter, just like the embodiment of Figs. 4-5e (col. 6, lines 18-20). For claim 5, what is traditionally considered the distal end of the hole is the proximal end of the hole. The device creates an ingress and egress prevention element once a clot has been formed. Regarding claims 14 and 15, the internal spring forces of the device cause the mesh to both “pull” and “push” the mesh as it expands.

Claim 15 is rejected under 35 U.S.C. 102(e) as being anticipated by Leschinsky (US 5,904,713). Leschinsky discloses a method of “sealing” a hole in a body

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comprising introducing a cylindrically shaped mesh 8 and 9 into a hole and pulling the distal end 8 of the mesh through an interior portion of itself (proximal end 9). The distal end 8 is simply inverted within the distal end 9. The hole is "sealed" in that the device is constricted about the perimeter of the passage.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(c) which forms the basis for all obviousness rejections set forth in this Office action:

(c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 12 and 13 are rejected under 35 U.S.C. 103(c) as being unpatentable over Forber et al. (US 5,733,294) in view of Ken (US 6,293,960). Forber does not disclose that the catheter or "tubular insert" 40 is inserted into the hole of the aneurysm. Nevertheless, Ken discloses a catheter inserted into an aneurysm to implant a device within the aneurysm. It would have been obvious to one of ordinary skill in the art at the time the invention was made to place the Forber catheter within an aneurysm as taught by Ken to accurately place the implant and ensure that the device does not expand prematurely preventing the device from entering the aneurysm. A push rod is used to advance the device out of the catheter. Ken does disclose removing the catheter to expel the device (col. 5, lines 48-53) and pushing the inserter tool 42.

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Allowable Subject Matter

Claims 10 and 11 are allowed. The prior art fails to disclose or suggest all of the limitations of the claims including the device used within a bony structure. Claims 4, 7 and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art fails to disclose or suggest all of the limitations of the claims including, "the proximal ["distal" in claim 7] end [is] advanced distally ["proximally" in claim 7] past the proximal end."

Response to Arguments

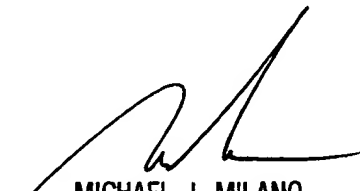
Applicant's arguments filed January 12, 2004 with respect to claims 1-14 are moot in view of the new grounds of rejection. With respect to the rejection under U.S.C. 102 over Leschinsky, the patent describes one of the legs as "substantially tubular." If one of the legs may be considered substantially tubular, then the device "comprises a generally cylindrical shaped mesh." In the alternative, the device as a whole, even though it is formed in two sections, appears to be generally cylindrical.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Jacob Davis whose telephone number is (703) 305-1232. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J. Milano can be reached on (703) 308-2496. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DJD
April 6, 2004



MICHAEL J. MILANO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700